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EXAMINER

KWON, BRIAN YONG S

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 07/11/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/807,603

Applicant(s)

TODO, SATORU

Examiner

Brian S Kwon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 and 57-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-53 and 57-105 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

In view of applicant's comments during telephonic interview which took place in July 2, 2002, the examiner withdraws the Restriction Requirement mailed May 29, 2002.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group (A)**, claim(s) 3-29, 33, 58, 61, 64, 67, 70, 73, 76, 79, 82, 85, 88, 91, 94, 97, 100 and 103 drawn to a composition containing sPLA2 inhibitor represented by formula (I)-(XXIV).

**Group (B)**, claim(s) 41, 48, 59, 62, 65, 68, 71, 74, 77, 80, 83, 86, 89, 92, 95, 98 and 104, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (I)-(XXIII).

**Group (C)**, claim(s) 52, 60, 63, 66, 69, 72, 75, 78, 81, 84, 87, 90, 93, 96, 99 and 105, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (I)-(XXIII).

The inventions listed as Groups (A)-(C) do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature linking groups (A)-(C) appears

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to that they all relate to a sPLA2 inhibitor represented by formula (I)-(XXIII). However, the claimed <sup>comparable compound</sup> compounds represented by formula (I)-(XXIII) are known in the art (EP 675110; US 5654326; US 5641800; EP 620214; (Draheim et al., J. Med. Chem. (1996), 39(26), 5159-5175); EP 675110; EP 620215; EP 675110; WO 96/031120; WO 9603376; WO 9603383; WO 9721664; WO 9721716; WO 9818464; WO 9824437; WO 9824756; WO 9824794; WO 9825609; US 5436258; US 5532366; US 5719149; US 5807829; US 5807829; US 5453443; EP 887342; WO 9847507; WO 9842343; WO 9837069). Therefore, the technical feature linking the inventions of groups A-C does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, Groups (A)-(C) are not linked by the same or a corresponding special technical feature as to form a single general inventive concept.

2. If applicant elects Group (A) invention, it is subject to further restriction as following because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as reasoned above.

**Group A-I**, claim(s) 3-7, 33, 58 and 103 drawn to a composition comprising formula (I)-(V).

**Group A-II**, claim(s) 8-11, 61 and 64, drawn to a composition comprising formula (VI)-(IX).

**Group A-III**, claim(s) 12-13 and 67, drawn to a composition comprising formula (X)-(XI).

**Group A-IV**, claim(s) 14-15 and 70, drawn to a composition comprising formula (XII).

**Group A-V**, claim(s) 16 and 73, drawn to a composition comprising formula (XIII).

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**Group A-VI**, claim(s) 17 and 76, drawn to a composition comprising formula (XIV).

**Group A-VII**, claim(s) 18 and 79, drawn to a composition comprising formula (XV).

**Group A-VIII**, claim(s) 19 and 82, drawn to a composition comprising formula (XVI).

**Group A-IX**, claim(s) 20 and 85, drawn to a composition comprising formula (XVII).

**Group A-X**, claim(s) 21 and 88, drawn to a composition comprising formula (XVIII).

**Group A-XI**, claim(s) 22-23 and 91, drawn to a composition comprising formula (XIX)-(XX).

**Group A-XII**, claim(s) 24-25 and 94, drawn to a composition comprising formula (XXI)-(XXII).

**Group A-XIII**, claim(s) 26-27 and 97, drawn to a composition comprising formula (XXIII-XXIV).

It is noted that claims 1-2, 30-32, 34 and 100 will be also examined to the extent that they read on an elected formula because they contain common limitation for Group (A).

3. If applicant elects Group (B) invention, it is subject to further restriction as following because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as reasoned above.

**Group B-I**, claim(s) 41, 48, 59 and 104, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (I) or (III) or (IV).

**Group B-II**, claim(s) 62 and 65, drawn a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (VI) or (VIII).

**Group B-III**, claim(s) 68, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (X).

**Group B-IV**, claim(s) 71, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XII).

**Group B-V**, claim(s) 74, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XIII).

**Group B-VI**, claim(s) 77, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XIV).

**Group B-VII**, claim(s) 80, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XV).

**Group B-VIII**, claim(s) 83, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XVI).

**Group B-IX**, claim(s) 86, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XVII).

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**Group B-X**, claim(s) 89, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XVIII).

**Group B-XI**, claim(s) 92, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XIX).

**Group B-XII**, claim(s) 95, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XXI).

**Group B-XIII**, claim(s) 98, drawn to a method of treating or preventing ischemia reperfusion injury with the composition containing sPLA2 inhibitor represented by formula (XXIII).

It is noted that claims 35-40, 42-47, 49, 57 and 101 will be also examined to the extent that they read on an elected formula because they contain common limitation for Group (B).

4. If applicant elects Group (C) invention, it is subject to further restriction as following because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as reasoned above.

**Group C-I**, claim(s) 52, 60 and 105, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (I) or (III) or (IV).

**Group C-II**, claim(s) 63 and 66, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (VI) or (VIII).

**Group C-III**, claim(s) 69, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (X).

**Group C-IV**, claim(s) 72, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XII).

**Group C-V**, claim(s) 75, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XIII).

**Group C-VI**, claim(s) 78, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XIV).

**Group C-VII**, claim(s) 81, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XV).

**Group C-VIII**, claim(s) 84, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XVI).

**Group C-IX**, claim(s) 87, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XVII).

**Group C-X**, claim(s) 90, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XVIII).

**Group C-XI**, claim(s) 93, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XIX).

**Group C-XII**, claim(s) 96, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XXI).



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**Group C-XIII**, claim(s) 99, drawn to a method of preserving extirpated organ with the composition containing sPLA2 inhibitor represented by formula (XXIII).

It is noted that claims 50-51, 53 and 102 will be also examined to the extent that they read on an elected formula because they contain common limitation for Group (C).

5. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as discussed above.

Applicant is required, in reply to this action, to elect a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. With the election of the specific species, a generic concept will be identified by the examiner as the inventive group for examination.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (703)308-5377. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Brian Kwon

**ZOHREH FAY**  
**PRIMARY EXAMINER**  
**GROUP 1600**

A handwritten signature in cursive script, appearing to read "Zohreh Fay", written in black ink.